



Patent  
Attorney Docket No. 032,290-111  
(formerly END-897DIV2)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**FOERSTER et al.**

**Serial No.: 10/630,883**

Filed: July 30, 2003

For: METHODS AND DEVICES FOR  
DEFINING AND MARKING TISSUE

Group Art Unit: 3737

Examiner: Eleni M. Mantis Mercader

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR §§ 1.97 and 1.98, the items identified in this Information Disclosure Statement ("IDS") are brought to the attention of the Office. The items are listed on the attached form PTO-SB/08a and PTO-SB/08b. Copies of the references have been provided for the convenience of the Examiner.

The items identified in this IDS may or may not be "material" pursuant to 37 CFR § 1.56. The submission thereof by Applicant is not to be construed as an admission that any such patent, publication or other information referred to therein is material or considered to be material (37 CFR § 1.97(h)), or even qualifies as "prior art" under 35 USC § 102 with respect to this invention unless specifically designated by Applicant as such.

**INFORMATION DISCLOSURE STATEMENT FILING PROVISION:**

☒ This IDS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is (1) within three months of the filing date of the application, which is not a continued prosecution application filed under § 1.53(d); or (2) within three months of entry of the national stage as set forth

**CERTIFICATE OF MAILING (37 C.F.R. §1.8a)**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

March 27, 2006  
Date of Deposit  
NB1:678450.1

*Cynthia B. Pacheco*  
Cynthia B. Pacheco

in 37 CFR § 1.491; or (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after filing a request for continued examination under § 1.114. Thus, no fee is required.

- ☒ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR § 1.17(p) to the deposit account referenced below.
- ☐ However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.
- ☐ This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office action on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311.
- ☐ The fee due under 37 CFR § 1.17(p) is submitted herewith.
- ☐ A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.
- ☐ This IDS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. A statement under 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is submitted herewith.

**Statement Under 37 CFR § 1.97(e):**

- ☐ Each item contained in this IDS was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.
- ☐ No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this statement after making reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this IDS.

Some references are in a language other than the English language. A concise explanation of relevance is given below.

**DE 935625**

This reference discloses a biopsy instrument and method for acquiring subcutaneous biopsies and for removing lesions.

**DE 4330958**

The invention relates to novel microparticles containing active compound, which, additionally to the active compound(s), contain at least one gas or gaseous phase, media (microparticulate systems) containing these particles, their use for the ultrasonically controlled in vivo release of active compound and process for the production of the particles and media.

**FR 2714284**

The prosthesis consists of a circular component made from a supple material with a shape memory effect, able to occupy three different positions. In the first position (2) it is extended lengthwise to form a small cylinder which can be introduced through a catheter, with its proximal end closed by a valve (4). In a second position the two compartments (8,10) are inflated separately so that they are deployed on opposite sides of the ruptured wall, while in the third position the compartments are squeezed together to form a double patch on the wall. The prosthesis has a radio-opaque marker (6) between the two compartments which allows its progress through the patient's body to be monitored.

**DE 4403789**

The invention relates to the use of coloured NMR, X-ray or possibly dye-containing ultrasonic-image-producing substances for marking bodily tissues.

**PAYMENT AND/OR AUTHORIZATION TO CHARGE FEES:**

- ☐ A check in the amount of \$180.00 is enclosed for the above fee(s).  
☐ Please charge \_\_\_\_\_ to Deposit Account No. **50-2862** for the above fee(s).

The Commissioner is authorized to charge any fees required by the filing of these papers, and to credit any overpayment to O'Melveny and Myers' Deposit Account No. **50-2862**.

Respectfully submitted,

O'MELVENY & MYERS LLP

Dated: March 27, 2006

By: Diane K. Wong  
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Substitute for form 1449A-PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Application No.	10/630,883
Filing Date	July 30, 2003
First Named Inventor	FOERSTER
Art Unit	3736
Examiner Name	Not Yet Assigned
Attorney Docket No.	032,290-111 (formerly END-897DIV2)

Sheet 1 of 4

**U.S. PATENT DOCUMENTS**

Examiner Initials	Cite No. <sup>1</sup>	Document No.	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
	1.	US 2,609,347	09/1952	Wilson	
	2.	US 2,653,917	09/1953	Hammon	
	3.	US 2,659,935	11/1953	Hammon	
	4.	US 2,664,366	12/1953	Wilson	
	5.	US 2,664,367	12/1953	Wilson	
	6.	US 2,846,407	08/1958	Wilson	
	7.	US 3,001,522	09/1961	Silverman	
	8.	US 3,823,212	07/1974	Chvapil	
	9.	US 4,230,123	10/1980	Hawkins	
	10.	US 4,320,201	03/1982	Berg	
	11.	US 4,248,214	02/1981	Hannah	
	12.	US 4,356,572	11/1982	Guillemin	
	13.	US 4,592,356	06/1986	Gutierrez	
	14.	US 4,744,364	05/1988	Kensey	
	15.	US 4,789,401	12/1988	Ebinger	
	16.	US 4,790,329	12/1988	Morris	
	17.	US 4,832,686	05/1989	Anderson	
	18.	US 4,900,304	02/1990	Fujioka	
	19.	US 4,970,298	11/1990	Silver	
	20.	US 5,080,655	01/1992	Haaga	
	21.	US 5,083,570	01/1992	Mosby	
	22.	US 5,148,813	09/1992	Bucalo	
	23.	US 5,158,084	10/1992	Ghiatas	
	24.	US 5,158,565	10/1992	Marcadis	
	25.	US 5,204,382	04/1993	Wallace	
	26.	US 5,207,705	05/1993	Trudell	
	27.	US 5,234,426	08/1993	Rank	

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\*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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		Number-Kind Code <sup>2</sup> (if known)			
	28.	US 5,325,857	07/1994	Nabai	
	29.	US 5,326,350	07/1994	Li	
	30.	US 5,334,216	08/1994	Vidal	
	31.	US 5,353,804	10/1994	Kornberg	
	32.	US 5,388,588	02/1995	Nabai	
	33.	US 5,394,886	03/1995	Nabai	
	34.	US 5,395,319	03/1995	Hirsch	
	35.	US 5,409,004	04/1995	Sloan	
	36.	US 5,411,522	05/1995	Trott	
	37.	US 5,423,321	06/1995	Fontenot	
	38.	US 5,445,167	08/1995	Yoon	
	39.	US 5,467,780	11/1995	Nabai	
	40.	US 5,469,854	11/1995	Unger	
	41.	US 5,479,936	01/1996	Nabai	
	42.	US 5,483,972	01/1996	Nabai	
	43.	US 5,507,813	04/1996	Dowd	
	44.	US 5,517,997	05/1996	Fontenot	
	45.	US 5,556,410	09/1996	Mittermier	
	46.	US 5,571,182	11/1996	Ersek	
	47.	US 5,645,566	07/1997	Brenneman	
	48.	US 5,647,374	07/1997	Crtter	
	49.	US 5,660,185	08/1997	Shmulewitz	
	50.	US 5,670,161	09/1997	Healy	
	51.	US 5,716,404	02/1998	Vicante	
	52.	US 5,752,974	05/1998	Rhee	
	53.	US 5,795,308	08/1998	Russin	
	54.	US 5,807,276	09/1998	Russin	
	55.	US 5,902,310	05/1999	Foerster	

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	56.	US 5,941,910	08/1999	Schindler	
	57.	US 5,980,564	11/1999	Stinson	
	58.	US 5,676,146 (B1)	04/2000	Scarborough	
	59.	US 6,053,876	04/2000	Fisher	
	60.	US 6,053,925	04/2000	Barnhart	
	61.	US 6,083,522	07/2000	Chu	
	62.	US 6,162,192	12/2000	Cragg	
	63.	US 6,174,330 B1	01/2001	Stinson	
	64.	US 6,220,248	04/2001	Voegele	
	65.	US 6,231,834	05/2001	Unger	
	66.	US 6,335,028	05/2001	Vogel	
	67.	US 6,271,278	08/2001	Park	
	68.	US 6,356,782	03/2002	Sirimanne	
	69.	US 6,371,904	04/2002	Sirimanne	
	70.	US 6,766,186	07/2004	Hoyns	

**FOREIGN PATENT DOCUMENTS**

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	71.	DE 0935625	11/1955			
	72.	EP 0255123	02/1988			
	73.	EP 0534696	03/1993			
	74.	DE 4330958	03/1995			
	75.	FR 2714284	06/1995			
	76.	DE 4403789	08/1995			
	77.	WO 9608208	03/1996			
	78.	EP 0769281	04/1997			

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	79.	WO 9847430	10/1998			
	80.	WO 0038579	07/2000			

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s) volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
	81.	CLARKSON, P.: "Sponge Implants for Flat Breasts," Proceedings of the Royal Society of Medicine, Vol. 53 at 880-881 (1960)	
	82.	DUFRANE, P. et al: "Prebiopsy Localization of Non-Palpable Breast Cancer," Journal Belgede Radiologie (October 1, 1990) Vol. 73, No. 5	
	83.	EPO Search Report dated December 5, 2003 for EPO Application number EP 03 07 5084	
	84.	FOURNIER et al: "Experimental Studies and Preliminary Clinical Trial of Vinorelbine-loaded Polymeric Bioresorbable Implants for the Local Treatment of Solid Tumors", Cancer Research 51, pp. 5384-5391, October 1, 1991	
	85.	HUSSMAN et al: "MR Mammographic Localization Work in Progress," Radiology, 189-915-917 (1993)	
	86.	HUSSMAN et al: "Optical Breast Lesion Localization Fiber: Preclinical Testing of a New Devie," Radiology, 200:865-866 (September 1996)	
	87.	PANGMAN, W.J. and WALLACE, R.M.: "The Use of Plastic Prosthesis in Breast Plastic and Other Soft Tissue Surgery," The Western Journal of Surgery, Obstetrics and Gynecology at 508 (August 1955)	
	88.	Surgical Treatment of Breast disease, Making the Diagnosis of Breast Cancer: Non-Palpable Breast Masses," BreastDoctor.com, <a href="http://breastdoctor.com/breast/surgery/biopsy.htm">http://breastdoctor.com/breast/surgery/biopsy.htm</a>	
	89.	Surgical Treatment of Breast Disease: What's New? Diagnosing Breast Cancer: The ABBI Breast Biopsy System, BreastDoctor.com, <a href="http://breastdoctor.com/breast/surgery/abbi.htm">http://breastdoctor.com/breast/surgery/abbi.htm</a>	

Examiner Signature	Date Considered	
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